

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

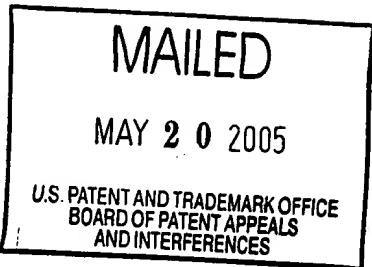
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte MICHAEL T. WHITE, CATHY A. MARTIN,  
MARY ANN MOORE and DAVID Z. NEILL

Appeal No. 2005-0690  
Application 09/469,633

ON BRIEF



Before KRASS, BLANKENSHIP, and MACDONALD, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-3, and 7.

The invention is concerned with enhancing security features of an automated order fulfillment system. In particular, a plurality of users of the system are subject to predetermined rules governing certain business conduct. A security profile, prepared for each user, identifies a set of authorized transactions which the user may perform. A list is prepared of pairs of incompatible transactions, i.e., transactions which are incompatible if performed by the same user. For example, one would not want a user in charge of shipping goods also authorized to determine price of the goods since there could be a possibility of fraud with that user shipping goods to himself/herself for free. Each security profile is compared to the list to identify security profiles including at least one pair of incompatible transactions, and a report is generated indicating those security profiles which include incompatible transactions and the user identifiers associated with those security profiles. The comparing and generation steps are automated.

Representative independent claim 1 is reproduced as follows:

1. A method for facilitating implementation of an automated system for transacting business, the system having a plurality of users, the users being subject to predetermined rules governing business conduct, the method comprising the steps of:

assigning a user identifier to each user of the system;

preparing a security profile corresponding to each identifier, each security profile including a set of authorized transactions;

preparing a list of pairs of incompatible transactions if performed by the same user in accordance with said predetermined rules;

comparing each security profile with said list, to identify security profiles including at least one pair of incompatible transactions; and

generating a report indicating those security profiles which include incompatible transactions and the user identifiers associated with those security profiles,

wherein said comparing step and said generating step are automated.

The examiner relies on the following references:

Rassman et al. (Rassman)	4,937,743	Jun. 26, 1990
Miller	6,101,481	Aug. 8, 2000
	(§102 (e) date: Jun. 30, 1998)	

Claims 1-3, and 7 stand rejected under 35 U.S.C. §103 as unpatentable over Miller in view of Rassman and Official Notice of certain facts.

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

OPINION

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the examiner must produce a factual basis supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The examiner may satisfy his/her burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

In the instant case, the examiner contends, in the final rejection (Paper No. 17), that Miller assigns a user identifier (at column 3, line 53, through column 4, line 8); prepares a security profile corresponding to each identifier, with each security profile including a set of authorized transactions (at

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column 3, line 53, through column 4, line 14, and column 11, line 64, through column 12, line 13), wherein the system of Miller allows incompatible/conflicting transactions to be locked out, providing security (column 12, lines 3-9).

The examiner recognizes that Miller lacks a specific teaching of the method including the steps of the users being subject to predetermined rules governing business conduct; preparing a list of incompatible transactions; comparing each security profile with the list to identify the security profiles with incompatible transactions; and generating a report (see page 2 of the final rejection).

Thus far, in the explanation of the rejection, the examiner appears to admit that Miller lacks basically the entire claimed subject matter.

The examiner turns to Rassman for a business computer system whereby conflicts involving resources are identified/listed, and indicia is employed to notify operators of conflicts. The examiner contends there is a teaching of automatic notification of such conflicts to relevant personnel and automatic adjustment

of schedules/resources to correct the conflict, pointing to column 3 of the reference.

The examiner then concludes that it would have been obvious to modify Miller to include the steps of preparing a list of incompatible transactions, comparing each security profile with the list to identify the security profiles with incompatible transactions, and generating a report, in view of Rassman, in order to provide a cost efficient system, pointing to column 2, lines 27-30, of Rassman.

Moreover, in an attempt to plug certain glaring deficiencies in the rationale for the rejection, the examiner relies on "Official Notice" that it is well known in business to create a list of incompatible transactions for certain employees and to monitor the transactions of the employees. The examiner proffers an example of a restaurant employee who would not be given both the job of the food preparer and the cash register handler since these jobs are incompatible to the extent that such an employee could give away food he prepared without charging the customer.

We will not sustain the rejection of claims 1-3, and 7 under 35 U.S.C. § 103 as, in our view, the examiner has failed to present a prima facie case of obviousness.

Miller is directed to a task management system wherein certain employees are assigned a task and only those employees assigned that task know the details of the task and may make changes and/or recommendations relative to that task. Those employees not assigned to a certain task are "locked out" in the sense that they are not privy to the details of the task. This "locked out" feature is Miller's security. However, there is no disclosure or suggestion in Miller of a "security profile," as claimed, wherein such profile corresponds to each identifier assigned to a user of the system and wherein each security profile includes a set of authorized transactions. Miller has no such "identifier" or "security profile." However, to the extent one might consider the assignment of a specific task to one or two employees to include identifying the user, and the tasks, or transactions, the employee is authorized to perform, Miller clearly lacks any preparation of a list of pairs of incompatible transactions if performed by the same user and Miller, just as clearly, lacks any comparison of a security profile with such a list of incompatible transactions. Moreover, Miller has no

teaching or suggestion of generating a report indicative of those security profiles which include incompatible transactions and the user identifiers associated with those security profiles.

The examiner's reliance on Rassman to provide for these deficiencies of Miller is misplaced. Rassman schedules, monitors, and manages resources within a system. We agree with appellants (see page 6 of the brief), in citing column 3, lines 2-21, of Rassman, that Rassman suggests automatic adjustment of schedules in the event of "scheduling conflicts" but that "conflicts" in Rassman refers to a lack or imbalance of resources, not to misuse of a system, or fraud, as in the instant invention. One might argue that "misuse of the system" and "fraud" are not claimed. However, the claims are directed to users being "subject to predetermined rules governing business conduct" and the claimed methods are clearly directed to automatic methods of transacting business in order to ensure that a user does not perform transactions which would be incompatible. Therefore, it does not appear reasonable to us for the examiner to rely on the "conflicts" of Rassman for any type of suggestion to modify Miller to monitor for incompatible transactions by a user.

Even in Miller, there is no suggestion of subjecting users to "predetermined rules governing business conduct" since Miller's "core business rules" are not related to business conduct of the employees, but, rather to how a certain task details is to be controlled and by whom. Miller does not teach keeping an employee from a certain task because of its incompatibility with another task that employee may be performing.

Moreover, the proposed combination of Miller and Rassman is questionable because the examiner has provided no convincing rationale as to why the skilled artisan would have sought to combine a personnel assignation system for efficient performance of tasks (as in Miller) with a resource scheduler which is not concerned with performing any transactions (as in Rassman).

We agree with appellants analysis, at pages 9-10 of the brief:

A combination of Miller and Rassman...would at best yield a system in which users would be delegated tasks or assigned to teams for performing tasks, and in which those users could monitor the availability of various resources and coordinate their use. In the cited references, the question of whether a given user should perform a given transaction is a matter of whether the user has been assigned a task (Miller) or a matter of whether appropriate resources are available (Rassman...). Neither of the

references, considered alone or in combination, suggests preparing a list of incompatible transactions in accordance with predetermined rules governing business conduct, as in the present invention...the cited references do not suggest that the comparing and generating steps are automated, as in the present invention.

Appellants do not dispute the examiner's Official Notice that it is well known for businesses to have certain business conduct guidelines and that a list of incompatible transactions may be developed manually from those guidelines. Appellants point to page 6, lines 11-16, of their specification for such an admission. But, appellants argue, the difference is that the instant invention performs the preparation of such a list, and the generation of a report "automatically." Appellants argue that the automation of these steps would not have been obvious from the non-automated development of known guidelines, or from the manual development of the list of incompatible transactions.

While there may well be an argument that could be made, or evidence that could be offered, regarding the obviousness of automating this well known manual procedure, the examiner has not made it. Instead, the examiner merely points to Miller as a teaching that it was well known to automate a security process (pointing to column 3, line 25, through column 4, line 19, of Miller) and to Rassman as a teaching that it was well known to

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have an automated system that identifies conflicts and notifies relevant personnel of the conflicts (pointing to column 3, lines 19-32, of Rassman).

We do not find the examiner's response convincing of obviousness, as none of the cited passages provides support for why it would have been obvious, within the meaning of 35 U.S.C. § 103, to have automated the preparation of a list of incompatible transactions, based on security profiles and identifiers of users, the comparison of security profiles with the list of pairs of incompatible transactions, and the generation of a report indicative of those security profiles which include incompatible transactions and the user identifiers associated with those security profiles. Moreover, the applied references offer no suggestion of the *specific* automated steps of the instant claims in the particular order claimed.

There are too many deficiencies in the examiner's rationale for us to sustain the rejection of the instant claims under 35 U.S.C. § 103.

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Accordingly, the examiner's decision rejecting claims 1-3,  
and 7 under 35 U.S.C. § 103 is reversed.

REVERSED

*Errol A. Krass*  
ERROL A. KRASS )

Administrative Patent Judge )

*Howard B. Blankenship*  
HOWARD B. BLANKENSHIP )

Administrative Patent Judge )

*Allen R. Macdonald*  
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